

“the applicant did not invent the claimed subject matter. The instant application as rejected below as double patenting list two inventors in the *identical* U.S. Patent 6 658 401 B2 which is commonly assigned. The listing of two inventors in the *identical* patent leads one to believe that the inventor of the instant application is not the ‘sole inventor’(emphasis added).”

The basis for the Examiner’s rejection under 35 USC 102(f) is the Examiner’s contention that claims 1-12 of the present application “are directed to the same invention as that of claims 1-17 of commonly assigned U.S. Patent No. 6 658 401 B2.”

A simple comparison of, for example, claim 1 of the present application to claim 1 of the ‘401 patent underscores the *differences* between the claimed inventions. Claim 1 of the present application recites second receiving means for receiving information “concerning possible infringement on said right.” Claim 1 of the ‘402 patent recites second receiving means for receiving information “for use in invalidating said right.” If these respective claims are applied to the context of, for example, the legal issue of patent infringement, claim 1 of the present application is concerned with transmitted information that relates to patent infringement; whereas claim 1 of the ‘402 patent is concerned with transmitted information that relates to invalidating the patent. That is, the claims of the present application are concerned with information that a patent holder might use to determine who is infringing upon his patent; and the claims of the ‘402 patent are concerned with information that the infringer might use to invalidate the patent holder’s patent. See, for example, the paragraph bridging pages 2 and 3 of the present application, which points out that the invention of the present application includes a “system allowing right holders to disclose their rights (patents, ...) in order to solicit information from around the world about possible infringement on their rights...” and compare this to column 2, lines 2-8 of the ‘402 patent, which points out that the invention

of the '402 patent includes a "system which allows unauthorized parties warned or sued by right holders to look for relevant materials for invalidating rights at issue..."

Thus, contrary to the Examiner's characterization of the claims of the present application and the claims of the '402 patent, the claimed inventions are **not identical**. In fact, the claimed inventions are directly opposite each other: one is intended to learn of, for example, patent infringement and the other is intended to learn of patent invalidity.


A comparison of the remaining claims of the present application to the remaining claims of the '402 patent leads to the very same conclusion: the claims of the present application are **not directed** to the same invention as that of the claims of the '402 patent. One who practices the claims of the present application would not infringe the claims of the '402 patent. Conversely, one who practices the claims of the '402 patent would not infringe the claims of the present application. Since this is the basis for a finding of no double patenting (see MPEP section 804 II A), it follows that the inventor of the claims of the present application did, in fact, invent the subject matter of those claims. Since the claims of the '402 patent are directed to an invention that is different from the invention claimed in the instant application, it should not be surprising that the inventive entity of the '402 patent differs from the inventive entity of the present application.

The sole inventor of the present application is Yoshimasa Utsumi. Yoshimasa Utsumi is a joint inventor with Shigeyuki Yoneyama of the '401 patent. Consistent with section 716.10 of the MPEP, this Response is accompanied by an unequivocal Declaration under 37 CFR 1.132, signed by sole inventor Yoshimasa Utsumi, stating that Yoshimasa Utsumi invented the subject matter disclosed but not claimed in the '401

patent, which the Examiner believes is "identical" to the subject matter of the claims of the present application.

Accordingly, it is respectfully requested that the rejection of claims 1-12 be withdrawn; and the present application be found in condition for allowance. An early notice to that effect is solicited.

Respectfully submitted,  
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